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EXAMINER

JEANTY, ROMAIN

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte : AKINOR TSUBOUCHI

Application No. 09/386,641
Technology Center 3600

Mailed: May 12, 2008

Before DALE M. SHAW *Chief Appeals Administrator*
SHAW, *Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL

This application was received at the Board of Patent Appeals and Interferences on March 24, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

EXAMINER'S CONSIDERATION OF AMENDMENT

The Examiner must consider and acknowledge receipt of the Amendment filed May 18, 2005, via written communication.

MPEP § 1206 states:

Examiners must respond to all amendments filed after appeal has been taken and prior to termination of the appeal. If the examiner indicates (in the advisory action) that an amendment would be entered, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be impacted by the entry of the amendment except where an amendment merely cancels claims.

EXAMINER'S ANSWER

An Examiner's Answer was mailed July 13, 2007 in response to an Order Returning Undocketed Appeal to Examiner mailed July 20, 2006. An examination of the Image File Wrapper (IFW) reveals that in the Final Rejection mailed August 30, 2004 the following rejections were made:

Claims 1, 3-17, 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter;

Claims 1, 3-5, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al (U.S. Patent No. 5,978,768) in view of Wagner "Employees selection makes Ritz tradition. (Ritz-Carlton Hotel Co.'s Targeted Selection Process employment program" as set forth in the last Office Action mailed on November 10, 2003; and

Claim 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurzius et al (U.S. Patent No. 6,385,620) in view of

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Wagner (Employees selection makes Ritz tradition (Ritz- Carlton Hotel Co.'s Targeted Selection Process employment program) or Jane (The computer Psychology) as set forth in the last Office Action mailed November 10, 2003.

However, the Examiner's Answer mailed July 13, 2007 introduced a new ground of rejection, where the Examiner listed the following rejections as follows:

Claims 1-5, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al (U.S. Patent No. 5,978,768) in view of Wagner "Employees selection makes Ritz tradition. (Ritz-Carlton Hotel Co.'s Targeted Selection Process employment program)";

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al (U.S. Patent No. 5,978,768) in view of Wagner "Employees selection makes Ritz tradition. (Ritz-Carlton Hotel Co.'s Targeted Selection Process employment program)" as applied to claim 1 and further in view of Jane (The Computer Psychologist);

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al (U.S. Patent No. 5,978,768) in view of Wagner "Employees selection makes Ritz tradition. (Ritz-Carlton Hotel Co. 's Targeted Selection Process employment program) as applied to claim 1 above and further in view of Puram et al (U.S. Patent No. 6,289,340);

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al in view of Wagner and in view of Puram et al as applied to claims 1 and 9 above and further in view of Haq et al (U.S. Patent No. 6,275,012);

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al in view of Wagner as applied to claims 1 and 9 above and further view of Feldbau et al (U.S. Patent No. 6,571,334); and

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Claim 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurzius et al(U.S. Patent No. 6,385,620) in view of Wagner (Employees selection makes Ritz tradition (Ritz- Carlton Hotel Co.'s Targeted Selection Process employment program)) or Jane (The computer Psychology).

MPEP § 1207.03 states:

Any new ground of rejection made by an examiner in an answer must be:

(A) approved by a Technology Center (TC) Director or designee; and
(B) prominently identified in the “Grounds of Rejection to be Reviewed on Appeal” section and the “Grounds of Rejection” section of the answer (see MPEP § 1207.02).

In addition, a review of the file indicates that the Examiner’s Answer is not in compliance with the headings as set forth in the new rules under MPEP § 1207.02, effective September 13, 2004. A substitute Examiner’s Answer in compliance with the new rules is required.

Evidence Relied Upon

The Evidence Relied Upon section of the Examiner’s Answer is defective. The Jane (“The Computer Psychologist”) reference was applied to the following statement of rejections in the Grounds of Rejection (pages 9 & 11) section of the Examiner’s Answer:

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGovern et al(U.S. Patent No. 5,978,768) in view of Wagner "Employees selection makes Ritz tradition.(Ritz-Carlton Hotel Co.'s

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Targeted Selection Process employment program)" as applied to claim1 and further in view of Jane (The Computer Psychologist); and

Claim 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurzius et al(U.S. Patent No. 6,385,620) in view of Wagner (Employees selection makes Ritz tradition (Ritz-Carlton Hotel Co.'s Targeted Selection Process employment program)) or Jane (The computer Psychology).

In accordance with MPEP § 1207.02, the “Evidence Relied Upon” (section 8) should include:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and
in the case of non-patent references, the relevant page or pages.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for the Examiner to consider the Amendment filed May 18, 2005;
- 2) vacate the Examiner’s Answer mailed July 13, 2007, and issue a revised Examiner’s Answer in accordance MPEP § 1702.02 and MPEP § 1702.03 noted above; and

for such further action as may be appropriate.

If there are any questions pertaining to this order, please contact the Board of

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Patent Appeals and Interferences at 571-272-9797.

DMS/tsj

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